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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/229, 173 01/13/99 CHATTERJEE D 0942.2800008

HM22/0316

EXAMINER

STERNE KESSLER GOLDSTEIN & FOX  
1100 NEW YORK AVENUE NW  
SUITE 600  
WASHINGTON DC 20005-3934

STOLE, E

ART UNIT	PAPER NUMBER
1652	5

**DATE MAILED:** 03/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. 09/229,173	Applicant(s) Chatterjee
Examiner Einar Stole	Group Art Unit 1652



- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- Claim(s) 1-10, 13, 16, 17, 19, 26, 28, 29, and 34-36 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-6, 9, 13, 16, 17, 19, 26, 28, 29, and 34-36 is/are rejected.
- Claim(s) 7, 8, and 10 is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

1. Claims 1-10, 12, 13, 16, 17, 19, 26, 28, 29, and 34-36 are presented for examination.

### ***Drawings***

2. The drawings are approved by the Official Draftsman.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

4. Claims 7, 8, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

See 37 CFR 1.130(b).

7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1-4 of U. S. Patent No. 5,948,614, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

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Specifically, claims 1-4 are each drawn to a species of the genus of claim 1 of the instant application.

The U. S. Patent No. 5,948,614 contains support for the claimed genus.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. Claims 2-6 are rejected under the judicially created doctrine of double patenting over claims 2-6, respectively, of U. S. Patent No. 5,948,614, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Specifically, claims 2-6 are each drawn to a species of the genus of each of claims 2-6 of the instant application. The U. S. Patent No. 5,948,614 contains support for the claimed genus.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

10. Claims 9, 13, 16, 17, 19, 26, 28, 29, 34, 35, and 36 are rejected under the judicially created doctrine of double patenting over claims 7, 11, 17, 25, 27, 28, 33, 34, and 136, respectively, of U.S.

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Patent No. 5,948,614, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Specifically, claims 7, 11, 17, 25, 27, 28, 33, 34, and 136 are each drawn to a species of the genus of claims 9, 13, 16, 17, 19, 26, 28, 29, 34, 35, and 36 of the instant application. The U. S. Patent No. 5,948,614 contains support for the claimed genus.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP

§ 804.

### *Conclusion*

11. No claims are allowed.
12. The Group and Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1652.
13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Einar Stole, Ph.D., whose telephone number is (703) -305-4507. The Examiner can normally be reached Tuesday through Friday 6:30 a.m. to 5:00 p.m.

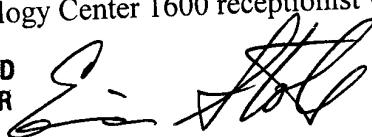
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If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ponnathatpura Achutamurthy, can be reached on (703)-308-3804. The FAX phone number for Technology Center 1600 is (703)-305-7401.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703)-308-0196.

EINAR STOLE, PH.D  
PATENT EXAMINER



March 9, 2000